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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,882	10/30/2003	Harumi Morino	58799-100	7806

7590 04/16/2007
McDermott, Will & Emery
600, 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

SCHMIDT, KARL L

ART UNIT	PAPER NUMBER
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2139

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/695,882

Applicant(s)

MORINO ET AL.

Examiner

Kari L. Schmidt

Art Unit

2139

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 3 & 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2139

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al (US 2003/005135 A1) in view of Serkowski et al. (US 2004/0044901 A1).

Inoue discloses a license management system comprising: a license server connected to a network (Fig. 22: (2210) "right management server"); and a terminal connected to the network (Fig. 22: (150) "terminal"); wherein said server includes: a first memory unit for storing a first license which includes a first use condition of content (Fig. 22: (2215) "user information management unit"); an issuance unit for, according to a request from said terminal page 19, paragraph [0159] "the license ticket generation unit receives, from the terminal for which a plurality of users are registered, the license ticket issuance request in which the owner of the right information..), issuing a second license which includes a content key for decrypting content and a second use condition set such that a value of said second use condition is within a value of said first use condition of said content (page 19, paragraph [0159] "with the authentication information ("content distribution server"), it generates the license ticket based on the right information of the user identified with authentication information for the terminal, the license ticket generation unit issues the license ticket with the temporary usage restriction registered in the temporary restriction database being appended to, in response to the license ticket issuance request from the temporary user registered in

the temporary usage restriction database; temporary license = second license"); and a transmission unit for transmitting to said terminal said second license that is issued; and wherein said terminal including includes (Fig. 22: (132) "distribution unit" distribute the second license to the terminal); and said terminal including (Fig. 22: (150) "terminal"): a license control unit for managing said second license transmitted from said server (Fig. 23: (2300) "temporary usage restriction"); and a reproduction unit for reproducing said content by use of said content key included in said second license (Fig. 22: (156) "content reproduction unit"); and wherein said server further includes: a second memory unit for storing information on said second license (Fig. 22: (2214)) which includes an expiration date/time for said terminal.

Regarding claim 2, Inoue discloses a server for issuing a content key for decrypting content, comprising: a first memory unit for storing a first license which includes said content key and a first use condition of said content (Fig. 22: (2215) "user information management unit"); an issuance unit for, when a value of a second use condition of said content requested by a terminal does not exceed a value of said first use condition stored in said memory unit, issuing a second license which includes said content key and said a second use condition (Fig. 23, page 20, [0162] "expiration date for registering the temporary user in the terminal information in the terminal"); a communication unit for transmitting said second license to said terminal (Fig. 22: (2214)).

Regarding claim 4, Inoue discloses the server as claimed in claim 2, wherein: said first use condition includes the maximum allowable number of simultaneous issues indicating a number of issues of said second license which can be distributed at the same time (page 18, [0155] "temporary usage restriction system is a content distribution system that permits registration of plurality of users on one terminal").

Regarding claim 5, Inoue discloses the server as claimed in claim 2, wherein: said license information includes return mode information indicating whether or not said second license is to be returned, said return mode information being provided for each second license; and (Fig. 28 and page 21, paragraph [0169]).

Regarding claim 6, Inoue discloses the server as claimed in claim 5, wherein said return control section is configured for setting said return mode information according to a request from said terminal (Fig. 32 and page 22, paragraph [0176] "the right information ID of the right information corresponding to the content selected on the license ticket issuance request screen, the authentication information and the terminal ID indicating the terminal on which the request is made are sent to the right management server" and page 21, paragraph [0171] "once the OK button is pressed, a command requesting the setting of more detailed content usage restriction is sent to the right management server").

Regarding claim 7, Inoue discloses the server as claimed in claim 5, wherein said return mode information includes information for determining whether said server is to automatically return said second license (page 21, paragraph [0172] "right management server that receives the command, the temporary usage restriction management unit reads out a temporary usage restriction template unit indicating the assumed choices of the temporary usage restrictions from the temporary usage restriction database..").

Regarding claim 8, Inoue discloses the server as claimed in claim 5, wherein said return mode information includes information for determining whether said terminal is to return said second license to said server (Fig. 10 S1009 to S1010; page 20, paragraph [0163] " usage restriction returns the second license to terminal control information database also can be set for the temporary usage restriction where its deleted").

Regarding claim 12, Inoue discloses the server as claimed in claim 2, wherein: said first use condition is determined by a manager of said content or a manager of said first license; and said second use condition is determined by a user of said content (Fig. 22 (2215): "user information management unit").

Regarding claim 13, Inoue discloses the server as claimed in claim 2, wherein: said first use condition includes a maximum allowable number of simultaneous issues indicating a number of issues of said second license which can be distributed at the same time (page 18, [0155] "content distribution system that permits registration of

plurality of users on one terminal." Fig. 23); when said issuance unit has issued said second license, said issuance unit decrements the maximum allowable number of simultaneous issues.

Regarding claim 14, Inoue discloses the server as claimed in claim 2, wherein: when said issuance unit has issued said second license, said issuance unit inhibits further issuance of said second license (Fig. 22 (113): "content usage right database" = issuance unit; (2217) "license ticket generation unit" = expiration date/time of said content has passed and page 20, paragraph [0163]: "An expiration data for registering the temporary user in the terminal information in the terminal information database is described in the terminal registration expiration date. When the date expires the temporary user's ID registered in the terminal information in the terminal information database is deleted."); and when said expiration date/-for said terminal has passed, said

Regarding claim 15, Inoue discloses the server as claimed in claim 2, wherein: said first use condition includes a first value of the number of reproduction operations of said content; said second use condition includes a second value of the number of reproduction operations of said content; when said issuance unit has issued said second license, said issuance unit subtracts said second value of the number of reproduction operations from said first value of the number of reproduction operations; upon receiving said second license returned from said terminal, said; and when an expiration date/time for said terminal has passed, said return control section maintains

Art Unit: 2139

said first value of the number of reproduction operations from which said second value of the number of reproduction operations has been subtracted to automatically restore to said return state of said second license (Fig. 22: (156) and page 15, paragraph [0131]: "content reproduction unit: the license ticket processing unit 154 confirms at regular time intervals whether the content reproduction unit 156 continues reproducing the content or not (S1207), and if it continues, interprets the license ticket 2 again, and decides whether the reproduction of the content is permitted or not (S1202). When the reproduction of the content is permitted depending upon the reproduction condition at that time, as a result of the interpretation of the license ticket 2 (S1203), the license ticket processing unit 154 further interprets the license ticket 1 (S1204), and decides whether the reproduction of the content is permitted or not at that time (S1205)", Fig. 23; page 20, [0162] "expiration date for registering the temporary user in the terminal information in the terminal" (page 4, paragraph [0059]: "subtracts the usage duration or usage number in this request from the read-out content rule so as to calculate the remaining usage duration or usage number and updates the right information using the calculation result and).

Regarding claim 16, Inoue discloses a terminal capable of communicating with a server for issuing a content key for decrypting content, said server comprising: a first memory unit for storing a first license which includes said content key and a first use condition of said content (page 3, [0058] "temporary usage restriction database"); an issuance unit for, when a value of a second use condition of said content requested

Art Unit: 2139

by said terminal does not exceed a value of said first use condition stored in said first memory unit, issuing a second license which includes said content key and said second use condition (page 19, paragraph [0159] "the license ticket generation unit receives, from the terminal for which a plurality of users are registered, the license ticket issuance request in which the owner of the right information...); and a communication unit for transmitting said second license to said terminal (Fig. 22, (119): "communication unit"); said terminal comprising (Fig. 22: (140 and 150)): a second memory unit for storing said content (Fig. 22 (155) "content storage unit"); a communication unit for receiving said second license from said server (Fig. 22, (152) "communication unit") a decryption unit for decrypting said content in said second memory unit by use of said content key included in said second license; a reproduction unit for reproducing the decrypted content according to said second use condition included in said second license (Fig. 22, (154): "license ticket processing unit").

Regarding claim 17, Inoue discloses the terminal as claimed in claim 16, wherein said reproduction unit updates said second use condition each time said reproduction unit reproduces said content (Fig. 22, (156) "content reproduction unit").

Regarding claim 18, Inoue discloses the server as claimed in claim 2, wherein: when said issuance unit has issued said second license in said first memory, said issuance unit changes said first use condition; (page 19, paragraph [0159] "the license ticket generation unit receives, from the terminal for which a plurality of users are

registered, the license ticket issuance request in which the owner of the right information.. and Fig. 22: (2214)).

Inoue doesn't specifically state a second memory unit for storing information on said second license which includes an expiration date/time for said terminal; and a return control section for automatically restoring to a return state of said second license when said expiration date/time for said terminal has passed, so that said issuance unit can issue said second license for another terminal.

Serkowski discloses a second memory unit for storing information on said second license which includes an expiration date/time for said terminal; and a return control section for automatically restoring to a return state of said second license when said expiration date/time for said terminal has passed, so that said issuance unit can issue said second license for another terminal (Abstract: "the licensing database comprising licensing database information associated with the identifier, the information comprising a licensing state indicator; and (iii) an activator, such as remote feature activator 112, operable to (a) authorize operation of the at least part of the computational component when the licensing state indicator has a first state and (b) not authorize operation of the at least part of the computational component when the licensing state indicator has a second state other than the first state. [0012]: return control section: "each time a licensed identifier is replaced with another identifier in the activation system, the identifier's status is automatically updated in the database to the

Art Unit: 2139

third state..." [0032-0037] are the states of the licenses and [0038] which have expiration date/time and client information " and [0028]: "licensing verification and issuance processes.").

It would have been obvious to one of ordinary skill in the art at the time of invention to have a return control section for automatically restoring to a return state of said second license when said expiration date/time for said terminal has passed, so that said issuance unit can issue said second license for another terminal that is disclosed in Serkowski. To protect software manufacturers' copyrights in software sold to the public, manufactures commonly license software to the purchaser. Additionally, particular software package for a customer premise telecommunication switching system contains a large number of features, and most customers elect to pay for only a subset of the total number of features so it would be obvious to add a return control section to keep track when license expired and be return to be issued to another (Serkowski: [0002]).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kari L. Schmidt whose telephone number is 571-270-1385. The examiner can normally be reached on Monday - Friday: 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2139

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KS

Taghi J. Arami
Primary Examiner
Jan 10, 2011
4/11/04